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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,929	02/09/2004	Gale H. Thorne	JMH002	8850

7590 10/01/2007  
Gale H. Thorne  
1056 Millcrest Circle  
Bountiful, UT 84010

EXAMINER
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EREZO, DARWIN P

ART UNIT	PAPER NUMBER
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3731

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10/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/774,929

Applicant(s)

THORNE ET AL.

Examiner

Darwin P. Erez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 22-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/18/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in the reply filed on 7/10/04 is acknowledged. The traversal is on the ground(s) that the instant invention provides selective control of both depth and width in the same scalpel. This argument is found persuasive and the restriction requirement for the different species is now withdrawn.

Claims 1-3 and 22-37 are still drawn to a non-elected invention and are still withdrawn from consideration.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 6/18/04 has been received and made of record. Note the acknowledged form PTO-1449 enclosed herewith.

### ***Specification***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Objections***

4. Claims objected to because of the following informalities:

In claim 6, line 3, "actuator parts" should read as "blade interfacing parts".

In claim 8, line 5, the period after "displaced" should be removed.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 8 recites the limitations "the guide edges", "the side stops" and "the components". There is insufficient antecedent basis for these limitation in the claim.

8. Claim 9 recites the limitations "the at least one stop" and "blade component". There is insufficient antecedent basis for these limitation in the claim.

9. Claim 10 recites the limitation "the components". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 4-11, 16-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,402,770 to Jessen in view of US 6,048,354 to Lawrence.

Jessen discloses a scalpel comprising: a housing **11**; a split scalpel blade **21** having a pair of sharpened points, said blade being within the housing; and an actuator **15, 17** comprising a plurality of blade interfacing parts by which the scalpel blade is manually displaced relative to the housing and to cause the blade to lance.

Jessen is silent with regards to the housing having an entry portal and an exit portal for receiving a guidewire. However, Lawrence discloses a similar cutting device, wherein the device has a housing that receives a needle **30**, which is used as a guidewire, to accurately guide the blade near the position of the needle. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the housing of Jessen to include a channel for a guidewire because it would more accurately place the incision at the desired location.

Jessen further discloses the scalpel blade being medially split to comprise two scalpel components **24** with a common hinge connection **22**; wherein the housing comprises stops and the blade comprises guide edges which interface to the actuator

parts and side stops to maintain the scalpel components aligned until the scalpel pierces the entry site to the predetermined depth (shown in Fig. 1); wherein the housing comprises at least one stop **23** for limiting travel of the scalpel blade components, thereby limiting depth of the lance and ending a first lancing motion of the scalpel; wherein blade has guide edges **41** on a wing thereof; wherein the actuator can be moved in selectable positions (depends on how far the actuator is moved distally); wherein the housing comprises a top part and a bottom part; wherein the modification to include a channel for the guidewire; wherein the device further includes a spring **14**.

13. Claims 12-14, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jessen in view of Lawrence, and in further view of US 5,571,132 to Mawhirt et al.

The above combination of Jessen/Lawrence discloses all the limitations of the claims except for a living hinge connecting the parts together. However, living hinge connection between housing parts are well known in the surgical art, as shown by Mawhirt in Fig. 2E. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made add a living hinge between the top and bottom parts of Jessen because such type of connection is well known in the art, as disclosed by Mawhirt.

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jessen in view of Lawrence, and in further view of US 4,730,613 to Gordy.

The above combination of Jessen/Lawrence teaches all the limitations of the claim except for the device having a depth adjustable nose guard. However, Gordy

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discloses a similar type of cutting device, wherein an adjustable nose guard is provided to adjust the depth of the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Jessen to have an adjustable nose guard because it would allow the user to control the depth penetration of the blade.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erezzo whose telephone number is (571) 272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erezol  
Examiner  
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